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Bruce E. Harang PO BOX 872735 VANCOUVER, WA 98687-2735			EXAMINER LARSON, JUSTIN MATTHEW	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

ED

**Office Action Summary**

Application No.

10/707,432

Applicant(s)

MCKENZIE ET AL.

Examiner

Justin M. Larson

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claims 1, 10, and 19 objected to because of the following informalities: All of the claims first recite, "storage receptacles, items, and brackets..." The claims go on to recite, "a desired container, item, and bracket..." It appears as though "container" should be "storage receptacle" in order to avoid confusion in the claims. Appropriate correction or clarification of this matter is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 10 the limitation "storage receptacles, items, and brackets having located thereon at least one prong suitable for inserting into said at least one mounting cavity" renders the claims indefinite because it is unclear how many of these storage receptacles, items, and brackets applicant is attempting to claim. The same is true for the limitation "storage receptacles, items, and brackets... having located thereon at least one mounting cavity" of claim 19. These storage receptacles, items, and brackets are being claimed as part of a combination. First, it is abundantly unclear how many of these storage receptacles, items, and brackets are included in that combination. The claims do recite that only one single storage receptacle, item, or bracket may be

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inserted into each mounting cavity of a mounting unit, however, this does not clarify how many storage receptacles, brackets, and items are included in the overall combination as claimed. Second, Applicant's originally filed disclosure states that "items" include cell phones, cd's, cups, bike racks, etc. [para 22]. It is therefore unclear what is sought to be covered by the term "item"; a cell phone? a cd? a cup? etc. The claims also recite that "at least one of a desired container, item, and bracket" can be secured via the inventive mounting apparatus, implying that Applicant is really only claiming one of either a container/receptacle, item, or bracket. The rejections that follow in this Office Action are based on the assumption that Applicant is really only claiming one of a container/receptacle, item, or bracket having at least one prong/cavity for mounting.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 5-11, and 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Heinz et al. (US 5,769,294 A).

Regarding claims 1, 2, 10, and 11, Heinz et al. disclose a device mounting apparatus suitable for attaching and securing items and receptacles having various sizes and shapes in a vehicle comprising in cooperative combination: a mounting unit (20, Figure 10), that in its closed position is completely hidden from view in an interior surface (26) of a vehicle having located therein a plurality of mounting cavities (hollow

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areas formed behind hooks 36); at least one storage receptacle/item/bracket (24) having located thereon a plurality of mounting prongs (multiple hangers have multiple prongs) suitable for inserting into said at least one mounting cavity (Figure 10); thereby allowing the secure attachment of at least one of a desired container/item/bracket (24) in a vehicle.

Regarding claims 5 and 14, the mounting unit rotates around pivot pins (52).

Regarding claims 6 and 15, the pivot pin (52) and its corresponding socket (50) allow for the turning or rotation of the mounting unit, effectively serving as a hinge along the mounting unit's outer edge (Figure 9).

Regarding claims 7 and 16, as the apparatus pivots open, it glides smoothly, or slides, and Examiner therefore considers the pivot mechanism to be a sliding mechanism.

Regarding claims 8, 9, 17, and 18, either of the cavities and prongs of Heinz et al. can be considered to be oriented either horizontally or vertically, depending on how you look at the figures.

Regarding claim 19, the selectively hidden mounting device (20) includes at least one prong (36) and at least one receptacle/container/item (22) has a cavity (opening in the bag handle) for attaching to the prong (Figure 1).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-6, 8-10, 12-15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempkers (US 4,221,354 A).

Regarding claims 1 and 10, Kempkers discloses a device mounting apparatus suitable for attaching and securing items and receptacles having various sizes and shapes in a vehicle comprising in cooperative combination: a mounting unit (40), that in its closed position is completely hidden from view in an interior surface of a vehicle having located therein at least one mounting cavity (50); at least one storage receptacle/item/bracket (clothing hangers) for inserting into said at least one mounting cavity (col. 2 line 65); thereby allowing the secure attachment of at least one of a desired container/item/bracket (hanger) in a vehicle. Kempkers fails to disclose the receptacle/item/bracket (clothing hangers) having prongs, however, because Applicant has not traversed Examiner's assertion of official notice, the fact that it is old and well known for clothing hangers to have a prong at the top from which the hanger is suspended is taken to be admitted prior art.

Regarding claims 3, 4, 12, and 13, Kempkers teaches that the mounting apparatus is made from polycarbonate.

Regarding claims 5 and 14, the mounting unit rotates around a pivot pins (41).

Regarding claims 6 and 15, the pivot pin (41) and its corresponding socket (20', 21') allow for the turning or rotation of the mounting unit, effectively serving as a hinge along the mounting unit's outer edge.

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Regarding claims 8, 9, 17, and 18, either of the cavities and prongs of Kempfers can be considered to be oriented either horizontally or vertically, depending on how you look at the figures.

### ***Double Patenting***

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. Claims 1-6, 8-15, and 17-18 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6, 8-15, and 17-20 of copending Application No. 10/707,432. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 7 and 16 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-20 of copending Application No. 10/707,432. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: In Application No. 10/707,432, the mounting device is claimed to open or close via either a pivot pin or hinge. These opening and closing mechanisms can be considered "slide mechanisms", as is currently claimed in the present application, since the motion of the mounting device as it is opened or closed using either of these mechanisms can be considered a sliding motion. Examiner is of the position that to slide is to glide or move smoothly.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.



***Oath/Declaration***

13. An oath or declaration by each actual inventor or inventors listing the entire inventive entity has not been submitted.

As it appears that a party required by 37 CFR 1.48(a)(2) to submit a statement of facts may not be willing to submit such statement, applicant should consider either: a) submission of a petition under 37 CFR 1.183 to waive that requirement if the original named inventor(s) has assigned the entire right and interest to an assignee who has given its consent to the requested inventorship correction, MPEP § 201.03, Statement of Lack of Deceptive Intention, or b) refiling the application (where addition is needed under 37 CFR 1.53(b) with a new oath or declaration and any necessary petition under 37 CFR 1.47, or where only deletion is needed, either under 37 CFR 1.53(b) utilizing a copy of a prior oath or declaration under 37 CFR 1.63(d)(1)(iv), or under 37 CFR 1.53(d))(design applications only), thereby eliminating the need for a 37 CFR 1.48 request.

Applicant is advised to review 37 CFR 1.183, 37 CFR 1.67, 37 CFR 1.48(a), MPEP 409.03 and MPEP 603. Additional help may also be obtained by contacting the Office of Petitions.

***Response to Arguments***

14. Applicant's arguments filed 3/16/07 have been fully considered but they are not persuasive.

Examiner notes that Applicant did not address paragraph 1 of the previously mailed Office action, regarding the Oath/Declaration, now presented again in paragraph 13 above.

Regarding the rejection of claims 1, 10, and 19 under 35 U.S.C 112, 2<sup>nd</sup> paragraph, Applicant has asserted that the description of multiple receptacles, items, and brackets capable of being used is proper. Examiner notes that the pending claims do not recite the receptacles, items, and brackets being capable of use with the claimed

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mounting apparatus. Instead, the claims recite the receptacles, items, and brackets as part of a combination. Therefore, despite Applicant's amendments to the claims and presented arguments, it is still unclear as to how many of said receptacles, items, and brackets are included in the claimed combination. Furthermore, it is unclear what is meant to be covered by the term "items", as this term has been associated with an indefinite plurality of physical objects in [para 22].

Regarding the Heinz et al. reference, Applicant has asserted that Heinz et al. do not teach or fairly suggest how to provide the hook mount (20) as a separate part that can be detachably mounted within the recess of the sidewall panel (26). Examiner notes that in the rejection set forth in paragraph 5 above, the hook mount (20) of Heinz et al. was equated to the claimed mounting unit. Nowhere in the claims is the mounting unit said to be provided as a separate part that can be detachably mounted within the recess of a sidewall panel. Applicant has essentially argued that Heinz et al. fails to teach unclaimed features. Examiner is of the position that Heinz et al. has been properly applied to the pending claims and all of the structural features encompassed therein.

Also regarding the Heinz et al. reference, Applicant mentions that Examiner took the position of "the bag handle is the cavity". Examiner notes that in paragraph 4 above, the claimed mounting cavity was set forth as being "(hollow areas formed behind hooks 36)", where the hooks are part of mounting unit (20). Nowhere did Examiner state that the cavities were the bag handles. The clothes hangers (24) of Heinz et al. are held within the cavities formed behind the hooks (36) of mounting unit (20). See especially Figures 10 and 12.

Regarding the Kempkers reference, Applicant has asserted that Kempkers does not teach or fairly suggest how to provide for a device which allows a plurality of different mounting units to be mounted within a mounting cavity such that different types of items may be securely mounted within the compartment of a vehicle. Examiner notes that in the rejection set forth in paragraph 8 above, the hook mount (40) of Kempkers was equated to the claimed mounting unit. Nowhere in the claims are a plurality of different mounting units claimed, where the mounting units are mounted within a mounting cavity such that different types of items may be securely mounted within the compartment of a vehicle. Applicant has essentially argued that Kempkers fails to teach unclaimed features. Examiner is of the position that Kempkers has been properly applied to the pending claims and all of the structural features encompassed therein.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Thursday, 7am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JML  
4/27/07

  
NATHAN J. NEWHOUSE  
SUPERVISORY PATENT EXAMINER